



Docket No. 64481/JPW/AJM/BJA
1632
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Isabelle Mansuy and Eric R. Kandel

Serial No. : 10/091,714 Examiner: Anne-Marie Falk

Filed : March 5, 2002 Group Art Unit: 1632

For : CALCINEURIN-RELATED TRANSGENIC MAMMALS,
COMPOSITIONS AND METHODS

1185 Avenue of the Americas
New York, New York 10036
January 28, 2005

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO DECEMBER 30, 2004 OFFICE ACTION

This Communication is submitted in response to December 30, 2004 Office Action issued in connection with the above-identified application. A response to the December 30, 2004 Office Action is due January 30, 2005. Accordingly, this response is being timely filed.

Restriction Requirement Under 35 U.S.C. §121

In the December 30, 2004 Office Action, the Examiner stated that restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1-10, drawn to a transgenic nonhuman mammal comprising a transgene as recited in the claims, wherein the transgene is present in germline cells and somatic cells (e.g., an animal generated by transgenesis), classified in class 800, subclass 13;
- II. Claims 1-10, drawn to a transgenic nonhuman mammal comprising the transgene as recited in the claims, wherein the transgene is present in somatic cells, but is not present in germline cells (e.g., an animal

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generated by in vivo somatic cell genetic modification or by transplantation of genetically modified cells), classified in class 800, subclass 8;

- III. Claims 11-20, drawn to a mammalian cell comprising a transgene as recited in the claims, classified in class 435, subclass 325;
- IV. Linking claim 21, drawn to a nucleic acid molecule or a pair of nucleic acid molecules as recited in Claim 21, or an acellular solution comprising the nucleic acid molecules, classified in class 435, subclass 320.1;
- V. Claims 31, 33, and 34, drawn to a method for determining whether an agent inhibits long-term potentiation in a mammal, classified in class 800, subclass 3; and
- VI. Claim 32, drawn to a method for determining whether an agent inhibits long-term potentiation in a cell, classified in class 435, subclass 4.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Group I, claims 1-10, drawn to a transgenic nonhuman mammal comprising a transgene as recited in the claims, wherein the transgene is present in germline cells and somatic cells.

Applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

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Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I-VI would necessarily identify art for the other Groups. Since there is no serious burden on the Examiner to examine Groups I-VI in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine claims 1-34 on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Assistant Commissioner for Patents,
Washington, D.C. 20231.

1/28/02
Alan J. Morrison
Reg. No. 37,399

John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400